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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,675	08/05/2003	Shinji Fujikawa	S0530.0001	6901

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EXAMINER
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KASZTEJNA, MATTHEW JOHN

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/633,675

Applicant(s)

FUJIKAWA ET AL.

Examiner

Matthew J. Kasztejna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/12/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,066,089 to Costello et al.

**In regards to claims 1-2, 10**, Costello et al. disclose an endoscope apparatus comprising: an elongated insert portion having flexibility, the insert portion being inserted into at least a space targeted for inspection; an endoscope main body having an apparatus main body used in combination with the insert portion; an endoscope housing case 100 which houses the endoscope main body therein; and an insert portion holding member 180 to hold the insert portion, the holding member being attachable to/detachable from the endoscope housing case together with the endoscope main body (see Col. 9, Lines 44-47 and Col. 11, Lines 1-25).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-9, 11-12, and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,066,089 to Costello et al. in view of U.S. Patent No. 5,314,070 to Ciarlei.

**In regards to claim 3**, Costello et al. disclose an endoscope apparatus but is silent with respect to wherein the endoscope apparatus is linked with the apparatus main body via a connector portion, and is composed of a scope unit comprising the insert portion. Cialei teaches of an analogous apparatus wherein the endoscope 14 has a connector 20 to the main body 22 and the endoscope (see Fig. 1). It would have been obvious to one skilled in the art at the time the invention was made to have a connector portion in the apparatus of Costello et al to allow for a more portable system as taught by Ciarlei.

**In regards to claim 4**, Costello et al. disclose an endoscope apparatus, wherein the insert portion holding member is provided detachably at the scope unit (see Col. 9, Lines 15-23).

**In regards to claims 5, 8-9 and 15-16**, Costello et al. disclose an endoscope apparatus but is silent with respect to wherein the insert housing portion is a housing portion which houses the insert portion therein. Cialei teaches of an analogous apparatus wherein a coil 24 houses the insertion tube 14 of the endoscope (see Fig. 2). It would have been obvious to one skilled in the art at the time the invention was made to have a housing portion which houses the insert portion in the apparatus of Costello et al. to provide better protection and prevent crushing of the insert portion as taught by Ciarlei.

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**In regards to claim 6**, Costello et al. disclose an endoscope apparatus, wherein the housing portion is capable of housing an operating portion to operate the endoscope main body (Col. 11, Lines 1-25).

**In regards to claim 7**, Costello et al. disclose an endoscope apparatus, wherein the insert portion holding member is provided to be fixed to the endoscope main body (see Fig. 1).

**In regards to claims 11-12, 14 and 17-18** Costello et al. disclose an endoscope apparatus but is silent with respect to an intermediate linking portion. Ciarlei teach of an analogous apparatus having a control section 17 positioned at the proximal end of the flexible insertion tube which controls flexible bending and observation of the scope unit (see Col. 2, Lines 36-64). It would have been obvious to one skilled in the art at the time the invention was made to have an intermediate linking section in the apparatus of Costello et al. to allow for control of the insert portion of the endoscope as taught by Ciarlei.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,066,089 to Costello et al. in view of U.S. Patent No. 5,863,286 to Yabe et al.

**In regards to claim 13**, Costello et al. disclose an endoscope apparatus but is silent with respect to an intermediate linking portion having a forceps inserting base connected to the manipulating device inserting channel and having an axis which is coincident with an axis of the manipulating inserting channel.. Yabe et al. teach of an analogous apparatus having a forceps channel and a forceps inlet opening through

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**In regards to claim 6**, Costello et al. disclose an endoscope apparatus, wherein the housing portion is capable of housing an operating portion to operate the endoscope main body (Col. 11, Lines 1-25).

**In regards to claim 7**, Costello et al. disclose an endoscope apparatus, wherein the insert portion holding member is provided to be fixed to the endoscope main body (see Fig. 1).

**In regards to claims 11-12, 14 and 17-18** Costello et al. disclose an endoscope apparatus but is silent with respect to an intermediate linking portion. Ciarlei teach of an analogous apparatus having a control section 17 positioned at the proximal end of the flexible insertion tube which controls flexible bending and observation of the scope unit (see Col. 2, Lines 36-64). It would have been obvious to one skilled in the art at the time the invention was made to have an intermediate linking section in the apparatus of Costello et al. to allow for control of the insert portion of the endoscope as taught by Ciarlei.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,066,089 to Costello et al. in view of U.S. Patent No. 5,863,286 to Yabe et al.

**In regards to claim 13**, Costello et al. disclose an endoscope apparatus but is silent with respect to an intermediate linking portion having a forceps inserting base connected to the manipulating device inserting channel and having an axis which is coincident with an axis of the manipulating inserting channel.. Yabe et al. teach of an analogous apparatus having a forceps channel and a forceps inlet opening through

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which a forceps can be inserted (see Fig. 5). It would have been obvious to one skilled in the art at the time the invention was made to have an intermediate linking section with a forceps inlet in the apparatus of Costello et al. to allow for the insertion of an instrument to the targeted site as taught by Yabe et al.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S Patent No. 6,846,285 to Hasegawa et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJK

*MK*

6/10/05

  
BEVERLY M. FLANAGAN  
PRIMARY EXAMINER